Hearing: Paper No. 17
June 4, 1998 PTH

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SunGard Development Corporation

Serial Nos. 75/031,718 and 75/031,719

Glenn A. Gundersen and Stephanie E. Thier of Dechert Price & Rhoads for SunGard Development Corporation.

David N. Mermelstein, Trademark Examining Attorney, Law Office 103 (Michael Szoke, Acting Managing Attorney).

Before Cissel, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

SunGard Development Corporation has filed intent-to-use applications to register the marks PANORAMA[1] and SUNGARD PANORAMA[2] for "computer software used by institutional and corporate capital market groups in managing market, credit and other financial risks in

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[1] Application Serial No. 75/031,718 filed December 12, 1995.
[2] Application Serial No. 75/031,719 filed December 12, 1995.

connection with the trading of securities, currency derivatives and other financial instruments."

The Examining Attorney has finally refused registration in each application pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the basis of Registration No. 1,357,720 for the mark PANORAMA for "computer programs and instructional manuals sold as a unit [and] computer magnetic storage discs."[3]

Applicant has appealed. Briefs have been filed and an oral hearing was held. Because both cases involve similar records and the identical issue, we will consider them in a single opinion.

Before turning to the merits of this case, we must first discuss an evidentiary matter. Applicant, for the first time in its brief on the case, listed a third-party application (75/146,119) and two registrations (1,880,414 and 2,047,381) in support of its contention that the cited mark is not entitled to a broad scope of protection. The Examining Attorney, in his brief, objected to this "evidence" as being untimely submitted. Applicant then filed a request to remand its application to permit

[3] Issued September 3, 1985; partial Section 8 affidavit filed. As will be discussed infra, when this registration issued, it covered additional goods.

introduction of copies of the third-party application and two registrations along with another third-party application (74/686,849). Accompanying the request were photocopies of the registrations and printouts of information concerning the applications taken from the TRADEMARKSCAN data base. In support of its request, applicant stated that "a clear pattern has emerged since the date of Applicant's final office action response in which four different narrowly-defined PANORAMA software marks have been approved for registration notwithstanding the breadth of the cited registration." The Board granted applicant's request and noted that "applicant states that the third-party registrations and applications were not in existence before the date of the applicant's last response but came into existence a few months prior to applicant's filing of the notice of appeal . . ."

It is the Examining Attorney's position that Registration No. 1,880,414 is not "new evidence" and was available prior to the filing of the appeal. Thus, the Examining Attorney maintains that the Board should not consider this registration. Further, the Examining Attorney argues that the printouts of the information concerning the applications should not be considered since they were taken from a private company's data base.

Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of the appeal and that the Board will ordinarily not consider evidence submitted after an appeal is filed. Although it appeared from applicant's statement in its remand request that Registration No. 1,880,414 was newly issued, it is clear that this registration issued well prior to the filing of the appeal and could have been made of record earlier. Thus, the Examining Attorney's objection is sustained.

Also, submission of printouts of information concerning applications or registrations taken from a private party's data base does not make the applications or registrations of record. The proper procedure to make applications or registrations of record, instead, is to submit copies of the actual registrations or the electronic equivalent thereof, i.e., printouts of the registrations taken from the Patent and Trademark Office's own computerized data base. See In re Melville Corp., 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Thus, we have given no consideration to Registration No. 1,880,414 or Application Serial Nos. 74/686,849 and 75/146,119.

We turn then to the issue of likelihood of confusion. With respect to the goods, applicant maintains that its

computer software is used for a highly specialized purpose and is sold to sophisticated purchasers, whereas the computer programs in the cited registration are for basic tasks such as word processing or document generation. According to applicant, even though the function of registrant's computer programs is not specified in the identification of goods because this was not a requirement that would have been made by the Patent and Trademark Office at the time the registration issued, the function of registrant's programs may be deduced from registrant's name ("Panorama Office Systems") and the context of the identification of goods as contained in the registration as originally issued ("Electronic data processors, word processors, keyboards, visual display units, printers, power and signal cables, computer programs and instructional manuals sold as a unit, computer magnetic storage discs, and daisy-wheel printers" in Class 9; and "Typewriters, typewriter ribbons and typewriter type elements" in Class 16). Further, applicant argues that the identification of goods in the cited registration should not be interpreted so broadly as to include all computer programs, particularly inasmuch as the Office now requires that any identification of goods for computer programs or comparable goods specify the purpose or function of the

programs and because the Office has allowed other PANORAMA marks for computer software where the purpose or function of the software is specified.[4]

The Examining Attorney, on the other hand, citing In re Linkvest, S.A., 24 USPQ2d 1716 (TTAB 1992), argues that because registrant's goods are broadly described as "computer programs," it must be presumed that registrant's goods encompass all types of computer programs, including the specific type sold by applicant.

The Examining Attorney acknowledges that Office practice has changed such that any identification of goods for computer programs must now specify the purpose or function thereof. Also, the Examining Attorney acknowledges that the question of the construction of a broadly worded identification of goods, particularly in regards to computer programs, is a recurring one. However, the Examining Attorney notes that *Linkfest* is still cited in the TMEP with approval, and argues that it would be unfair for the Board, in effect, to narrow the scope of the registrant's identification of goods in a proceeding such

[4] In urging reversal of the refusal to register, applicant also points to a concurring opinion in a decision of the Board which was not designated for publication in full. Such decisions, with certain exceptions not applicable here, are not citable as precedent, even if a copy of the decision is submitted. See TMBP 101.03 and cases cited therein.

as this ex parte appeal, where registrant is not even a party.

That the question of likelihood of confusion must be determined on the basis of the goods set forth in an applicant's application and those in the cited registration, rather than on what the evidence may show them to be, is a well established principle. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Additionally, it is well settled that where a registrant's goods are broadly described in its registration so as to include types of goods which are identical or similar to an applicant's goods, then that applicant in an ex parte case cannot argue that, in point of fact, registrant actually uses its mark on goods which are dissimilar to applicant's. In re Elbaum, 211 USPQ 639 (TTAB 1981).

Nevertheless, the Board has, on at least one occasion, looked to extrinsic evidence, not for the purpose of narrowing the description of goods in a cited registration, but for the purpose of ascertaining the precise nature of the goods. See In re Trackmobile, Inc., 15 USPQ2d 1152, 1154 (TTAB 1980). ["… when the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description

in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade."] See also: In re Protection Controls, Inc., 185 USPQ 692, 694 (TTAB 1975) ["… [T]he identification of goods in the [cited] registration as "monitoring instrument," per se, is so indefinite and so all inclusive as to be meaningless in attempting to ascertain whether the respective monitoring apparatus [of applicant and registrant] relate to the same or disparate fields … [T]he better approach in this particular situation … is to authorize publication of the mark for opposition …"); and Acomb v. Plywood Plastics Corp., 187 USPQ 188, 190 (TTAB 1975) ["Judicial interpretation, as reflected by decisions of this and other tribunals, has accorded a registration in which the goods are recited in a general rather then a specific manner a broad scope of protection sufficient to cover all types of the particular product or products enumerated therein. However,… in the instant case, 'molded wood products consisting of particulate wood and resin' [the description of goods in the cited registration] is so broad and comprehensive as to be devoid of any information as to just what molded wood products are marketed by opposer."]

We believe this case presents a situation similar to those above. The description "computer programs" is so broad and comprehensive as to be devoid of any information as to just what computer programs are marketed by registrant.[5] Thousands of computer programs are sold in today's marketplace for diverse purposes, and it is highly unlikely that any single company markets every type of computer program. Indeed, the Trademark Examining Group has recognized that "computer programs" is an outdated description and applicants are now required to specify the function or purpose of their computer programs.[6] It is, therefore, improper to simply consider the description "computer programs" in a vacuum and attach all possible interpretations to it where, as here, there is evidence from which we may determine the nature of registrant's computer programs. Stated differently, in this case we believe it is appropriate to consider the entire identification of goods at the time the registration issued in order to ascertain the nature of registrant's computer programs. Considering then that the registration, when issued, covered various office supplies and equipment for

[5] We note, in this regard, that the Microsoft Press Computer Dictionary (3d. 1997), at page 111, defines "computer program" as "[a] set of instructions in some computer language intended to be executed on a computer so as to perform some task."
[6] See TMEP §804.03(b).

document production, it would be unreasonable to read registrant's "computer programs" so broadly as to include all types of computer programs, including those for managing market, credit and other financial risks in connection with the trading of securities, currency derivatives and other financial instruments. Rather, a reasonable reading of the registration leads us to conclude that registrant's "computer programs" are for document production, e.g., word processing.

We reject, however, applicant's argument that the function of registrant's computer programs may be deduced from registrant's name ("Panorama Office Systems"). It is common knowledge that a company often starts in one field and then expands into other areas, yet retains its original name. In such a situation, the original name is not an accurate reflection of the products the company markets. Thus, we have not considered registrant's name in determining the nature of registrant's computer programs.

There are significant differences between computer programs for document production and applicant's highly specialized computer software for financial applications used by institutional and corporate capital market groups. The latter are generally demonstrated before purchase and are sold to very sophisticated purchasers. The former are

not. For the foregoing reasons, we find that applicant's use of the marks PANORAMA and SUNGARD PANORAMA for computer software used by institutional and corporate capital market groups in managing market, credit and other financial risks in connection with the trading of securities, currency derivatives and other financial instruments is not likely to cause confusion with registrant's mark PANORAMA.[7]

We wish to make clear that we are not overruling, nor could we, the legal principle set forth by our principal reviewing Court that, in determining likelihood of confusion in ex parte cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. We have simply considered the information provided in the entire registration, as issued, in determining the nature of the goods set forth therein. Had there been no, or insufficient, information therein from which to base such a determination, the Board would have been obliged to presume that registrant's goods included all types of computer programs. If, based on that, we had found that there was a

[7] As for applicant's argument that the cited mark is not entitled to a broad scope of protection because other registrations/ applications have issued and/or been approved by the Office since issuance of the cited registration, only one such registration is properly of record, i.e., Registration No. 2,047,381. The existence of this registration was not a basis for our decision herein.

likelihood of confusion, applicant's remedy would then have been to petition to restrict the registration. See Section 18 of the Trademark Act.

Moreover, if registrant's computer programs are not of the nature we have determined them to be, and registrant believes it will be damaged by registration of applicant's mark, registrant is free to oppose.

Decision: The refusal to register is reversed in each case.[8]

R. F. Cissel

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

[8] We recognize that the Examining Attorney was constrained to make this refusal due to Office practice. We commend him on his thorough discussion of the issues in this case.